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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,960	01/26/2001	Jo Ann H. Squier	10247	7021

23455 7590 05/15/2003

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EXAMINER
SIMONE, CATHERINE A

ART UNIT	PAPER NUMBER
1772	10

DATE MAILED: 05/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-10

Office Action Summary	Application No.	Applicant(s)	
	09/770,960	SQUIER ET AL.	
	Examiner	Art Unit	
	Catherine Simone	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 March 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

RESPONSE TO AMENDMENT

Withdrawn Rejections

1. The 35 U.S.C 112 rejection of claim 24 of record in Paper #8, Page 2, Paragraph #2 has been withdrawn due to the Applicant's amendment in Paper #9.

Repeated Rejections

2. The 35 U.S.C. 103 rejection of claims 1-8 and 10-26 over Balaji et al. in view of Bright is repeated for reasons previously of record in Paper #8, Pages 2-5, Paragraph #4.

3. The 35 U.S.C. 103 rejection of claim 9 over Balaji et al. in view of Bright and further in view of Katsura et al. is repeated for reasons previously of record in Paper #8, Page 6, Paragraph #5.

Response to Arguments

4. Applicant's arguments filed March 6, 2003 have been fully considered but they are not persuasive. Applicant states that "Interestingly, in-mold labeling as disclosed in Balaji is completely irrelevant to a preferred application of the present invention, which is to apply to claimed labels to a glass container, such as a beer bottle. The present examples illustrate the application of labels onto glass container. Glass containers are not and cannot be labeled by in-mold labeling." In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "glass containers") are not recited in the rejected claim(s). Although the claims are interpreted in

light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant further states that "The disclosure at column 4, lines 39-42 of Bright merely discloses that Bright's glue applicator can be used to apply several different kinds of adhesives, including hot melt glue and cold glue, to containers or substrates in applications where the container or substrate to be labeled has already been formed. Indeed, the entirety of Bright's disclosure relates to labeling in applications where the container or substrate to be labeled has already been formed, e.g., post-mold labeling (Applicant's refer, for example, to the disclosure at column 4, lines 18-22). Bright's disclosure does not at all relate to in-mold labeling, and nowhere does Bright disclose or teach the provision of a cold-glue adhesive on a polymeric label for in-mold labeling." In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "in-mold labeling") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, "in-mold labeling" is a method of forming the product and is not germane to the issue of patentability of the product itself.

Applicant further states that "For each of the foregoing reasons, the combined disclosures of Balaji and Bright cannot be combined and do not lead a person of ordinary skill in the art to the present invention." In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some

teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Bright was merely cited for suggesting that it is old and notoriously well-known in the analogous art to have a cold glue adhesive for the purpose of adhering a polymeric label to a container. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the label in Balaji et al. with a cold glue adhesive as suggested by Bright in order to adhere a polymeric label to a container.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (703) 605-4297. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Catherine Simone
Examiner
Art Unit 1772

May 5, 2003

HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

5/12/03